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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant: John Musacchia, Jr.
Serial No.: 09/174,868
Filed: October 19, 1998
For: ELEVATED GAME CALL WITH ATTACHMENT FEATURE
Examiner: Urszula M. Cegielnik
Group: 3712
Attorney: Gerald E. Helget
Attorney Docket No.: 33057.1
Additional Fees: Charge to Deposit Account 02-3732

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Sir:

APPELANT'S REPLY BRIEF

This Reply Brief is submitted under 37 CFR 1.193 to the Examiner's Answer mailed April 29, 2003.

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By *Gerald E. Helget*
Date 6/24/03

I. ARGUMENT

A. The rejected claims are patentable over the device of the Musacchia patent under Federal Circuit case law.

In the Answer, the Examiner states that “if the examiner was to agree with Appellant’s arguments, it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

This ancient authority, although never expressly overruled by the Supreme Court, was cited for the last time in a published decision of the C.C.P.A. in 1938.¹

Since that time, however, the Federal Circuit has ruled on several occasions that a one-piece vs. two-piece construction alone is not sufficient to make an invention obvious.

In *In re Helmond*², the Court stated:

“In rejecting the involved claims the primary examiner applied the general rule, that there is no invention in forming a member in one piece instead of several pieces together, where no change in function or operation is involved...

...the sole question to be decided by us is...do the facts in this case bring it within a recognized exception to the general rule applied by the tribunals of the Patent Office.

...it appears to us that the problem presented in making the rack bar of Kurowski in one piece presents something more than merely making in one piece that which had formerly been made in three pieces. We are of the opinion that it would not

¹ See Westlaw Keycite printout, Ex. A.

² 29 C.C.P.A. 795, 124 F.2d 222 (C.C.P.A. 1941)

be obvious to one skilled in the art to modify the Kurowski device so as to make a rack of one piece construction.”³

In *In re Jones*⁴, the claims under appeal (claims 6 and 8) claimed a “cap being formed of plastic material and providing a one piece structure...”⁵ The prior art disclosed a cap having more than one piece.⁶ In reversing the decision of the Board of Appeals rejecting the claims, the Court stated:

“In our opinion the rejected claims not only patentably distinguished from the prior art, but also the notion of forming a cap as appellant has done, is an inventive conception.”⁷

Finally, in *Carl Schenck, A.G. v. Nortron Corp.*⁸, the Court extensively discussed the defense of making a structure in one piece not rising to the standard of invention.⁹

The defendant, Nortron, argued that “the present invention was merely the forming of that structure in one piece, a step, Norton says, that would have been obvious to those skilled in the art at the time the invention was made.”¹⁰

In its opinion, the Court stated:

“In its argument that the invention here is but making integral what had earlier been made in four bolted pieces, Norton seeks to limit the focus of inquiry to a structural difference from the prior art and then to show that that difference *alone* would have

³ id.

⁴ 39 C.C.P.A. 913, 195 F.2d 538 (C.C.P.A. 1952)

⁵ id.

⁶ id.

⁷ id.

⁸ 713 F. 2d 782 (Fed. Cir. 1983)

⁹ id. at 784.

¹⁰ id. at 785.

been obvious. That effort is not proper under the statute, which requires that an invention be considered 'as a whole', 35 U.S.C. § 103. As Judge Nixon recognized, 'the emphasis on nonobviousness is one of inquiry, not quality.' *Graham v. John Deere Co.* 383 U.S. 1, 15 L.Ed. 2d 545, 86 S.Ct. 684 (1966). The inquiry here establishes that the present invention includes the inventor's elimination of the need for damping. Because the insight was contrary to the understanding and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art. *United States v. Adams*, 383 U.S. 39, 15 L.Ed.2d 572, 86 S.Ct. 708 (1966)."

The above cases show established Federal Circuit precedent that making in one piece an article that has formerly been formed in two pieces and put together is *not* always merely the exercise of routine skill in the art. The facts of each case must be considered.

Here, the only reference cited against the claims is the Musacchia patent. In the instant application, Appellant has distinguished this patent and points out the advantages of his invention over the patent. Furthermore, Appellant has shown that Musacchia teaches away from making a one-piece game call and elevating device as claimed.

In addition, the Supervisory Examiner is simply wrong in stating that Musacchia discloses a one piece game call and elevating device. Clearly, the holder 10 and call 30 are separate pieces which are held in place by a retainer element 44. If they were a single piece, there would be no need for the retainer element. Furthermore, Appellant's discussion of Musacchia at page 3 of the instant application makes it clear that "one piece" as used by Appellant does not include the Musacchia device.

In addition, the Supervisory Examiner's position in the Answer (that Musacchia discloses a one-piece construction) directly contradicts the position that Examiner Cegielnik took in the Final Office Action, where she stated that


"Musacchia discloses the claimed invention *except for the game call device constructed in one piece as recited in claims 1, 10, 14, and 17.*" (emphasis supplied)

Appellant wrote its Appeal Brief in response to the above-cited position of Examiner Cegielnik. It is certainly not proper for the Supervisory Examiner to change the earlier Examiner's position by one hundred eighty degrees in the Answer, without affording the Appellant an opportunity to present contra arguments. This is effectively a new ground of rejection which is prohibited by 37 C.F.R. § 1.193.

For the above reasons, Appellant respectfully requests the Board to overturn the Examiner's rejections and allow the claims under appeal.

Respectfully submitted,

Dated: 6/24/03

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KEYCITE

CITATION: ▷ **Howard v. Detroit Stove Works**, 150 U.S. 164, 14 S.Ct. 68, 37 L.Ed. 1039 (U.S.Mich., Nov 13, 1893) (NO. 64)

History
Direct History

- => 1 **Howard v. Detroit Stove Works**, 150 U.S. 164, 14 S.Ct. 68, 37 L.Ed. 1039 (U.S.Mich. Nov 13, 1893) (NO. 64)

Negative Indirect History (U.S.A.)

Distinguished by

- H 2 **General Electric Co. v. City of Dunkirk**, 211 F. 658 (W.D.N.Y. Jun 11, 1913) ★ ★

Citing References

Positive Cases (U.S.A.)

★ ★ Cited

- H 3 **M. Swift & Sons v. W.H. Coe Mfg. Co.**, 102 F.2d 391, 395, 40 U.S.P.Q. 631, 631 (C.C.A.1 (R.I.) Mar 02, 1939) (NO. 3394) "" (BNA Version)
- C 4 **Welsh Mfg. Co. v. Sunware Products Co.**, 236 F.2d 225, 227, 110 U.S.P.Q. 161, 161 (2nd Cir.(N.Y.) Jul 09, 1956) (NO. 310, 23924) (BNA Version)
- C 5 **Herzog v. Charles Keller & Co.**, 234 F. 85, 86, 148 C.C.A. 101, 101 (C.C.A.2 (N.Y.) May 09, 1916) (NO. 243)
- C 6 **General Electric Co. v. Yost Electric Mfg. Co.**, 139 F. 568, 570, 71 C.C.A. 552, 552 (C.C.A.2 (N.Y.) May 24, 1905) (NO. 149)
- H 7 **American Seating Co. v. Southeastern Metals Co.**, 412 F.2d 756, 758, 162 U.S.P.Q. 329, 329 (5th Cir.(Ala.) Jun 11, 1969) (NO. 26007) (BNA Version)
- C 8 **Kay Jewelry Co. v. Gruen Nat. Watch Case Co.**, 40 F.2d 600, 603, 5 U.S.P.Q. 112, 112 (C.C.A.6 (Ohio) May 13, 1930) (NO. 5452) (BNA Version)
- H 9 **Wagner v. Meccano, Limited**, 246 F. 603, 609, 158 C.C.A. 573, 573 (C.C.A.6 (Ohio) Nov 16, 1917) (NO. 2977, 3014)
- 10 **Coss v. Detroit Forging Co**, 230 F. 455, 456, 144 C.C.A. 597, 597 (C.C.A.6 (Mich.) Feb 08, 1916) (NO. 2662)
- ▷ 11 **Bullock Electric Mfg. Co. v. General Electric Co.**, 149 F. 409, 418, 79 C.C.A. 229, 229 (C.C.A.6 (Ohio) Dec 04, 1906) (NO. 1550)
- ▷ 12 **Standard Caster & Wheel Co. v. Caster Socket Co.**, 113 F. 162, 165, 51 C.C.A. 109, 109 (C.C.A.6 (Mich.) Dec 17, 1901) (NO. 1016)
- C 13 **Overweight Counterbalance Elevator Co. v. Henry Vogt Mach. Co.**, 102 F. 957, 961, 43 C.C.A. 80, 80 (C.C.A.6 (Ohio) May 08, 1900) (NO. 770)
- ▷ 14 **Pyle Nat. Co. v. Lewin**, 92 F.2d 628, 630, 35 U.S.P.Q. 40, 40 (C.C.A.7 (Ill.) Sep 15, 1937) (NO. 6070) (BNA Version)
- H 15 **Laclede-Christy Clay Products Co. v. City of St. Louis**, 280 F. 83, 85 (C.C.A.8 (Mo.) Apr 24, 1922) (NO. 5830)
- H 16 **D. J. Murray Mfg. Co. v. Sumner Iron Works**, 300 F. 911, 912 (C.C.A.9 (Or.) Aug 04, 1924) (NO. 4231)
- C 17 **Maunula v. Sunell**, 155 F. 535, 540 (C.C.D.Or. Aug 12, 1907) (NO. 3046) ""
- ▷ 18 **Joyce, Inc. v. Fern Shoe Co.**, 32 F.Supp. 401, 403, 45 U.S.P.Q. 243, 243 (S.D.Cal. Apr 11, 1940) (NO. 661-M) (BNA Version)
- 19 **Meurer Steel Barrel Co. v. Boyle Mfg. Co.**, 9 F.2d 92, 96 (S.D.Cal. Dec 14, 1925) ""
- H 20 **Hookless Fastener Co. v. G. E. Prentice Mfg. Co.**, 6 F.Supp. 176, 178 (D.Conn. Jul 28, 1932) (NO. 2133)

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- H 22 Laclede Christy Clay Products Co. v. City of St. Louis, 270 F. 338, 342 (E.D.Mo. Jan 08,
1921) (NO. 5174)
- C 23 Manzel v. Houde Engineering Corporation, 25 F.Supp. 40, 44, 39 U.S.P.Q. 180, 180
(W.D.N.Y. Aug 23, 1938) (NO. 1902) (BNA Version)
- H 24 Linde Air Products Co. v. Morse Dry Dock & Repair Co., 239 F. 909, 917 (E.D.N.Y. Jan
22, 1917)
- C 25 General Electric Co. v. Yost Electric Mfg. Co., 131 F. 874, 877 (C.C.S.D.N.Y. Jul 30, 1904)
- C 26 Electric Ry. Co. of the U.S. v. Jamaica & B.R. Co., 61 F. 655, 668 (C.C.E.D.N.Y. May 03,
1894)
- H 27 H W Johns Mfg Co v. Robertson, 60 F. 900, 905 (C.C.S.D.N.Y. Mar 31, 1894)
- ▶ 28 Meccano, Limited, v. Wagner, 234 F. 912, 924 (S.D.Ohio Jun 12, 1916) (NO. 23)
- ▶ 29 Philadelphia Rubber Works Co v. Portage Rubber Co, 227 F. 623, 628 (N.D.Ohio Apr 08,
1915) (NO. 149)
- C 30 Hensel-Colladay Co v. Rosenau, 105 F. 968, 969 (C.C.E.D.Pa. Jan 29, 1901) ""
- H 31 Summer Infant Products, Inc. v. Playskool Baby Products, Inc., 963 F.Supp. 86, 88 (D.R.I.
Mar 12, 1997) (NO. 92-267B)
- H 32 Standard Stoker Co. v. Berkley Mach. Works & Foundry Co., 29 F.Supp. 349, 368+, 39
U.S.P.Q. 268, 268+ (E.D.Va. Oct 26, 1938) (NO. 233-235) (BNA Version)
- ▶ 33 Claude Neon Electrical Products v. Brilliant Tube Sign Co., 40 F.2d 708, 710+, 5 U.S.P.Q.
37, 37+ (W.D.Wash. Mar 28, 1930) (NO. 601) (BNA Version)
- H 34 Mooney v. Brunswick Corp., 489 F.Supp. 544, 561, 206 U.S.P.Q. 121, 121 (E.D.Wis. Mar
21, 1980) (NO. 74-C-323) (BNA Version)
- C 35 In re Prinzler, 97 F.2d 102, 104, 25 C.C.P.A. 1254, 1257, 37 U.S.P.Q. 789, 789 (Cust. &
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- H 39 Wolff v. E.I. Du Pont De Nemours & Co., 122 F. 944, 958 (C.C.D.Del. May 29, 1903)
- C 40 Sheffield Car Co. v. D'Arcy, 194 F. 686, 692, 116 C.C.A. 322, 322 (C.C.A.6 (Mich.) Feb
13, 1912) (NO. 2155)
- C 41 D'Arcy v. Staples & Hanford Co., 161 F. 733, 742, 88 C.C.A. 606, 606 (C.C.A.6 (Mich.)
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- C 42 Olmsted v. A.H. Andrews & Co., 77 F. 835, 840, 23 C.C.A. 488, 488 (C.C.A.7 (Ill.) Jan 04,
1897) (NO. 157)
- C 43 Anchor Cap & Closure Corporation v. Linhardt, 56 F.2d 542, 543, 12 U.S.P.Q. 310, 310
(C.C.A.8 (Mo.) Feb 09, 1932) (NO. 9161) (BNA Version)
- C 44 Fullerton Walnut Growers' Ass'n v. Anderson-Barngrover Mfg. Co., 166 F. 443, 456, 92
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- H 45 De Lamar v. De Lamar Mining Co, 117 F. 240, 248, 54 C.C.A. 272, 272 (C.C.A.9 (Idaho)
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- C 46 In re Fleuss, 41 App.D.C. 520, 525 (App.D.C. Feb 02, 1914) (NO. 901)
- C 47 Man-Sew Pinking Attachment Corp. v. Chandler Mach. Co., 33 F.Supp. 950, 954, 46
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- H 48 Bernz v. Schaefer, 205 F. 49, 52 (D.N.J. May 06, 1913)
- C 49 Outlook Co. v. Malco Products Corporation, 299 F. 996, 1005 (E.D.N.Y. May 21, 1924)
- H 50 Handel Co. v. Jefferson Glass Co., 265 F. 286, 292 (N.D.W.Va. May 01, 1920)

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